

REMARKS

Claims 28-56 remain in this application. Claims 1-27 were canceled previously. Applicant respectfully requests reconsideration and review of the application in view of the following remarks.

The Examiner objected to Claim 34 as including an informality. The Applicant has amended Claim 34 to correct the informality.

The Examiner also rejected Claims 33-36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Applicant has amended Claim 33 in a manner that is believed to satisfy the requirement. This ground of rejection should therefore be withdrawn.

The Examiner also rejected Claims 28-42 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 42 and 45 are amended to provide proper antecedent basis. Claim 28 is amended to clarify that the second information is being updated at the location on a computer network to reflect the first information. These claims are now considered to be sufficiently definite, and this ground of rejection should be withdrawn.

The Examiner again rejected Claims 28-31, 40-45, and 50 under 35 U.S.C. § 103(a) as being unpatentable over Card et al. in view of Werb et al., and Claims 32-39, 46-49, and 51-54 as being unpatentable over Card et al. and Werb et al., and further in view of UPS ("Track by Tracking Number"). These rejections are respectfully traversed.

Card et al. discloses a data communication manager that provides an interface between different types of bar code scanners and a central computer system. The scanners read package tracking numbers and communicate that information via RF link to the data manager. The data manager uses stored disposition data to determine appropriate disposition of the package.

The Examiner acknowledges that Card et al. fails to disclose an RFID tag or the receiving of information stored in the memory of an RFID tag. To make up for this deficiency, the Examiner proposes the combination of Card et al. with Werb et al. Werb

et al. discloses an article tracking system that includes RFID tags.

The Applicant reiterates its view that there is no teaching or suggestion in the references to combine the data communication manager of Card et al. with the RFID tags disclosed by Werb et al. The Examiner has merely selected unrelated prior art references in an attempt to reconstruct Applicant's invention. It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985), the Federal Circuit noted that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." Likewise, in *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), the Federal Circuit admonished against hindsight reconstruction of an invention in the manner reflected by the present rejections. According to the Federal Circuit:

[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

See also *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) ("As in all determinations under 35 U.S.C. § 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.")

In response to this argument, the Examiner states that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is

proper." Respectfully, this is not an accurate statement of the law.

The examination approach suggested by the Examiner falls squarely into the impermissible use of hindsight proscribed by the Federal Circuit. Particularly, the Examiner used the present patent application as a template and selected the Card et al. and Werb et al. references solely for their teaching of selected aspects of the claimed invention. There is nothing in the references themselves or elsewhere in the knowledge of the prior art that suggested a combination of these references. The Federal Circuit is unambiguous in its admonition against "hindsight reconstruction of the claimed invention," and does not recognize as permissible the "reconstruction based upon hindsight reasoning" relied upon by the Examiner.

The Federal Circuit has further stated that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is a *rigorous application* of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added). In this regard, the Examiner's analysis falls woefully short.

The Examiner states that "Werb expressly discloses that 'machine-readable codes' or tags used in the disclosures of Card are improved upon by the RFID tag." The actual passage from Werb recites: "RFID systems are usually deployed as high-end replacement technology for bar coding." Werb et al., col. 1, lns. 24-25. This general statement hardly satisfies the "rigorous application" standard mandated by the Federal Circuit. Werb does not say that a bar code data communication methodology of the type disclosed by Card would be applicable to RFID systems, nor does it say that bar code data communication technologies can be modified for use with RFID systems, nor does it say that it would be desirable to use bar code data communication technologies with RFID systems, nor even does it say that the technologies are interchangeable. While any of these statements might be sufficient to show teaching or modification to combine references, they are certainly not present here.

As discussed previously, even if such a teaching or suggestion for the proposed

combination were present, the cited references fail to disclose any claim of the present invention. Card et al. discloses that a tracking number is read by a scanner from the bar code affixed to a package, and the data communication manager verifies the tracking number and communicates that information to the host computer. The data communication manager compares the tracking number to numbers that are on a table (see col. 15, Ins. 48-50). If the tracking number does not appear on the table, then the data communication manager adds the tracking number to the list and notifies the host computer of the added tracking number (see col. 17, Ins. 1-3). Card et al. does not disclose the manner in which the host computer uses the tracking number.

Significantly, the tracking number is *not* an address identifying a location on a computer network—it is merely an identifier for the bar code. When the data communication manager of Card et al. encounters a tracking number it does not recognize, it has no way to access information on a network corresponding to the tracking number. In contrast, in the present invention, when an RFID tag having an embedded address is encountered, the scanner can readily access the file on the network associated with the RFID tag—even if the data collection system had never previously encountered this RFID tag. This is because the address information stored in the RFID tag tells the scanner where to look for the information on the network. This is inherent in the nature of network addresses. Card et al. completely fails to disclose how a computing device could use the tracking number to automatically access information on a network relating to the package. Werb et al. and UPS each fail to make up for this significant deficiency of Card et al., and the Examiner fails to show how this capability would have been suggested to those of ordinary skill in the art.

On this point, the Examiner states that “the method of using a URL to communicate with a web site on a global network is known to exist in the art and to use such a method to update the location of a package would have been obvious to one of ordinary skill in the art at the time the invention was made.” The Examiner cites no prior art references for this statement, and it therefore cannot be ascertained what factual

basis, if any, the Examiner has for this assertion. Indeed, the use of an RFID system in this manner is expressly taught by the present patent application, and the Examiner has not carried his burden of showing that this teaching was known in the prior art. This is an example of the Examiner inferring a teaching of the present application into the prior art.

More specifically, the proposed combination of references fails to suggest or disclose a method for reading an RFID tag that includes, *inter alia*, the steps of "receiving first information stored in a memory of said RFID tag, said first information including an address identifying a location on a computer network corresponding to said RFID tag ... [and] communicating with said location identified by said address," as defined in Claims 28 and 50. The proposed combination of references further fails to suggest or disclose a computer network system for reading RFID tags that includes, *inter alia*, "an RFID tag ... having a memory containing at least an address identifying a location on a computer network," as defined in Claim 43. The proposed combination of references further fails to suggest or disclose an RFID tag that includes, *inter alia*, "a memory ... including a data field containing an address identifying a location on a computer network corresponding to said RFID tag," as defined by Claim 55.

The rejection of Claims 28-54 based on the cited prior art should therefore be withdrawn. To the extent that the Examiner persists with these grounds of rejection, the Applicant respectfully requests that the Examiner cite actual prior art references to support his position rather than relying upon general assertions of teachings of the prior art as set forth in the present Office Action.

The Examiner also rejected Claims 55-56 under 35 U.S.C. § 103(a) as being unpatentable over Maynard. This rejection is respectfully traversed.

Maynard discloses an RFID tagging system for computer network assets. The Examiner acknowledges that Maynard fails to disclose a memory containing an address identifying a location on a computer network corresponding to the RFID tag. But, the Examiner asserts that "these differences are only found in the nonfunctional descriptive

Serial No. 09/515,297
June 24, 2004
Page 14

materials and are not functionally involved in the steps recited." The Examiner is mistaken insofar as Claims 55-56 recites an RFID tag in apparatus form and does not limit the claims to any method or function steps. The limitation recited is an affirmative structural limitation of the claims, and cannot be dismissed by the Examiner as "nonfunctional descriptive materials." It is improper for the Examiner to ignore affirmative structural limitations of the claims in this manner. This ground of rejection should therefore be withdrawn.

Accordingly, the Applicant respectfully submits that Claims 28-56 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. If it would be helpful to placing this application in condition for allowance, the Applicants encourage the Examiner to contact the undersigned counsel and conduct a telephonic interview.

To the extent necessary, Applicant petitions the Commissioner for a three-month extension of time, extending to June 29, 2004, the period for response to the Office Action dated December 29, 2003. The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



Brian M. Berliner
Attorney for Applicant
Registration No. 34,549

Date: June 24, 2004

O'MELVENY & MYERS LLP
400 South Hope Street
Los Angeles, CA 90071-2899
Telephone: (213) 430-6000